UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,295	10/28/2003	Lawrence Morrisroe	085804-010801	5110

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EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
04/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/696,295	MORRISROE ET AL.
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _01 April 2009_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-28 and 31-33_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-28 and 31-33_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

This office action is in response to the Request for continued Examination, filed February

06, 2009 and to the amendment filed April 01, 2009. Applicant amended claims 1-4, 7-11, 13,

14, 16, 22-28, 31-33. Claims 1-28 and 31-33 are still pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7-10, 11, 12, 16, 18-21, 24-26 and 31-33 are rejected under 35

U.S.C. 102(b) as being anticipated by DoubleClick, as disclosed in DoubleClick International,

1/08/2001; (http://demo.doubleclick.com/generators/docs/designer_version.pdf) hereinafter

DoubleClick.

Regarding claim 1, DoubleClick teach *combining at a server* an ad input file (Flash file,

FLASH banner ads, FLASH movie) with a conduit file (click tracking string, ClickTag) to

automatically create a single integrated ad file having a single file extension (swf file) *containing*

both the ad input file and the conduit file (ActionScript used to combine the clicktag together

with the movie); *wherein the conduit file comprises of computer code (*ClickTag) *for tracking*

data for the ad, and serving the integrated ad file from a computer to provide the ad (see pp 1-3);

Regarding claim 4, DoubleClick teaches the use of Macromedia Flash; wherein the ad is

Flash ad and the files are "swf" files (see pp 1-3)

Regarding claims 7-10, DoubleClick teaches the ad including one or more actions for linking to one or more web pages and wherein the ad input file specifies one or more button actions, each having an exit code ...; the integrated ad file includes html code loading a JavaScript file, for loading the integrated ad file; tracking the ad using the code in the conduit file and tracking identifier; the html code including a variable and the conduit file includes code that determined where the ad opens in a parent window or new window based on the variable (see pp 3).

Regarding claims 11, 12 and 24-26, DoubleClick teaches identifying a first file (Flash movie file); identifying a second file (tracking string (ClickTag)); wherein the first file specifies ad content code and the second file contains ad-tracking code; electronically inserting the second file into the first file to create a file having a single file extension (swf); wherein the first file specifies ad content code and the second file contains an ad-tracking code (see pp 1-3).

Regarding claims 16, 18-21, DoubleClick teaches identifying a first file (tracking string (ClickTag1); identifying a second file (tracking string (ClickTag2)); identifying a third file (Flash movie); identifying a first placeholder and second placeholder in the third file and electronically inserting the first and second file into the first and second placeholder respectively to create a single integrated ad file having a single file extension (swf); wherein the first file includes a tracking data; html code loading ad file (third file); third file including one or more buttons; wherein   (see pp 1-3).

Regarding claims 31 and 32, DoubleClick teaches the integrated ad file includes one or more exit code referring to one or more URL variables; wherein the integrated ad file is designed to be loaded and wherein the ad is provided (see pp 2-3).

Regarding claim 33, DoubleClick teaches the ad is provided to a user computer via the

Internet and combining of the files is in response to receiving a request for a Web page and

serving the integrated ad file as par of the web page (see pp 2&3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 2, 3, 5, 6, 13, 15, 17, 22, 23, 27 and 28 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Doubleclick, as applied to claim 1 above, in view of Official Notice.

Regarding claims 2, 3, 13, 14, 22, 23 and 28, DoubleClick teaches each time the

destination URL has to be modified (for whatever reason) the FLASH file has to be sent back to

the design agency to be modified. DoubleClick also teaches by using variables to pass the click

tracking string into Flash movies instead of modifying the FLASH file itself only the variable in

the Rich Media Field is changed. Therefore, it would have been obvious to one of ordinary skill

in the art at the time of the invention to known that the designer or programmers of DoubleClick

would accept a new or modified information or content from the source and insert the same or

different tracking information according to the goals of the campaign or the preference of the

tracking server.

Regarding claims 5 and 6, DoubleClick teaches Flash Movie (swf file) but does not

explicitly teaches the file includes an empty movie object and inserting the conduit file in the

empty movie object; wherein the empty movie clip is given a predefined name and searching for

the predefined name. However official notice is taken that old and well known in the art of

Macromedia Flash to create an empty movie clip using Macromedia Flash, one that contains no

data or graphic content, so that external files (JPGS or SWF) can be loaded into it. Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to use the

empty clip as a placeholder for external file such as the tracking data, if the ad is a movie clip.

Regarding claims 15, 17 and 27, DoubleClick does not explicitly teach identifying a

placeholder (an empty movie clip) in the first file and electronically inserting the second file in

the placeholder to create an ad file. However official notice is taken that is old and well known in

the art of programming to create empty movie clip using Macromedia Flash. Macromedia Flash

is used to create an empty movie clip, one that contains no data or graphic content, so that

external files (JPGS or SWF) can be loaded into it. Therefore, it would have been obvious to one

of ordinary skill in the art at the time of the invention to create an empty movie clip, in rich

media, as a placeholder for external files such as the tracking data to be inserted, if the ad is a

movie clip.

Response to Arguments

Applicant's arguments with respect to claims 1-28 and 31-33 have been considered but

are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

DoubleClick, DoubleClick International; Flash Tracking with Variables 1/8/01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622